

REMARKS

Claims 1-17 are pending.

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) over "applicants' acknowledged state of the art," or Japanese Publication No. 11-192671 ("JP 671"), in view of U.S. Patent No. 4,310,581 to Felter et al. ("Felter"). The rejection is respectfully traversed for the following reasons.

Claim 1 recites a laminated product, which comprises a fiber reinforced resin layer, "an elastic layer laminated on one surface of said fiber reinforced resin layer," and "a surface protection layer laminated on the surface of said elastic layer for protecting the surface of said elastic layer." The cited art fails to disclose or suggest the claimed laminated product for the following reasons.

As described at page 3, lines 15-26, of the present specification, JP 671 discloses a laminated product including a urethane-based resin layer on a fiber reinforced resin layer. At page 4, lines 1-8, of the present specification, it is explained that the laminated product disclosed in JP 671 "is excellent in dimensional stability and suitable for use as a flooring material while maintaining characteristics of the urethane-based resin, i.e., abrasion resistance, impact resistance and the like."

Although the laminated product disclosed in JP 671 excels in performance and application ability, the present inventors discovered that the laminated product could still be

improved. Particularly, it was discovered that stain is more likely to attach on the surface of the softer urethane-resin. It was also discovered that the urethane-based elastomer is vulnerable to particular organic solvents. In addition, it was discovered that it is difficult to apply a pattern on a urethane-based resin by printing, or the like. *See* page 4, line 9 - page 5, line 6, of the present specification.

The claimed laminated product provides improvements as compared to the JP 671 laminated product. The claimed laminated product comprises a surface protection layer laminated on the surface of the elastic layer. The surface protection layer provides stain resistance, abrasion resistance, and chemical resistance. These properties can be provided for various elastic layer compositions. In addition, the claimed laminated product provides dimensional stability, which is maintained during construction, as well as after construction. *See* the paragraph bridging pages 6-7 of the present specification.

As admitted in the Office Action, JP 671 fails to suggest a laminated product including a surface protection layer laminated on the surface of an elastic layer, as recited in claim 1.

However, the Office Action asserts that Felter cures the deficiencies of JP 671. Applicants respectfully disagree. Felter discloses surface covering articles produced by aligning and embedding hollow or metallic fibers in a translucent binder or medium (column 2, lines 6-9). The surface covering articles have visual qualities of a finished

wood product. Felter discloses that the binder or medium in which the hollow and metallic fibers are embedded should be comprised of a material that is at least sufficiently translucent so that there will be no interference with light scattering properties of the fibers (column 2, line 65 - column 3, line 1). Materials that can be used for the medium are disclosed at column 3, lines 6-11, of Felter. Urethane resin is not included in the disclosed group of materials.

Felter also discloses that a decorative pattern may be applied to one surface of a thin, transparent wear layer, which can then be applied by pressure and heat to the outer surface of the article. The wear layer may be a poly(vinyl chloride) film (column 3, lines 54-58).

Felter fails to provide motivation to modify the laminated product disclosed in JP 671 in a manner to achieve the laminated product recited in claim 1. Felter fails to disclose or suggest applying the transparent wear layer on a urethane resin, let alone the urethane resin layer of the laminated product disclosed in JP 671.

As explained above, the laminated product disclosed in JP 671 provides the characteristics of the urethane-based resin; namely, abrasion resistance, impact resistance, and the like. Felter does not disclose or suggest that the JP 671 laminated product could be improved by providing a protection layer on a surface of the underlying elastic layer to protect the surface. Felter does not disclose or suggest that the material of the wear layer

has improved stain resistance, chemical resistance, or abrasion resistance properties as compared to the urethane resin material of the JP 671 laminated product. Clearly, Felter does not disclose or suggest that applying the wear layer on the JP 671 urethane resin layer would result in a product having improved stain resistance, chemical resistance, and abrasion resistance, as compared to the JP 671 laminated product.

Furthermore, the Office Action fails to establish a reasonable expectation of success resulting from modifying the JP 671 laminated product by applying the Felter wear layer over the urethane resin layer. Felter fails to disclose or suggest that the transparent wear layer would be compatible with urethane resin. In addition, the Office Action fails to establish that the Felter wear layer would be physically, chemically, or aesthetically compatible with the urethane resin layer of the JP 671 laminated product. In light of the omissions of the cited art, Applicants respectfully submit that the rejection is based on speculation regarding how the asserted modification might affect the JP 671 laminated product. The rejection is improper for this additional reason. *See, In re Warner*, 154 USPQ 173, 178 (CCPA 1967).

Thus, because the Office Action fails to establish motivation to modify JP 671, and a reasonable expectation of success resulting from the modification, a *prima facie* case of obviousness has not been established. *See* MPEP §2143. Therefore, claim 1 is patentable.

Claims 2-17 recite additional features of the laminated product that are neither disclosed nor suggested by JP 671 or Felter. For example, claim 3 recites that "said surface protection layer is transparent, and said elastic layer is applied with a pattern on the surface on which said surface protection layer is laminated." In contrast, Felter discloses that the decorative pattern may be applied to one surface of the wear layer applied to the outer surface of the article.

Claim 4 recites that "said elastic layer and said surface protection layer are transparent, and said fiber reinforced resin layer is applied with a pattern on the surface of on which said elastic layer is laminated." The subject matter recited in claim 4 also is not disclosed or suggested by JP 671 or Felter.

Claim 5 recites that "said surface protection layer is a film made of a polyamide resin." As explained at page 22, lines 3-12, polyamide films are highly superior to urethane-based resins in a Taber abrasion test, and also are less susceptible to stain. Felter fails to disclose or suggest a wear layer made of a polyamide resin.

As mentioned above, Felter discloses that the wear layer may be of poly(vinyl chloride). However, as described at page 1, line 20 - page 2, line 9, of the present specification, vinyl chloride resin has a large linear expansion coefficient and is inferior in dimensional stability after application. Consequently, vinyl chloride resin is prone to swelling and contraction. In contrast, JP 671 discloses that the laminated product has

"superior dimensional stability." In light of the large linear expansion coefficient of vinyl chloride resin, the Office Action fails to establish a reasonable expectation of success resulting from modifying the JP 671 laminated product by applying the Felter poly(vinyl chloride) wear layer over the urethane resin layer.

Furthermore, Felter fails to disclose or suggest the superior results that are provided by a protection layer made of a polyamide resin film, as recited in claim 5. These superior results rebut any alleged *prima facie* case of obviousness.

Thus, claims 2-17 also are patentable for at least the same reasons as those for claim 1. Withdrawal of the rejection is therefore respectfully requested.

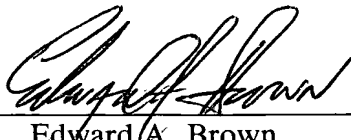
For the foregoing reasons, withdrawal of the rejection and prompt allowance of the application are respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: June 18, 2003

By: _____


Edward A. Brown
Registration No. 35,033

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620